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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052625
Party	Plaintiff Nautica Apparel, Inc.
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Date	05/20/2011
Attachments	Response to motion to compel discovery 5-20-11.pdf (14 pages)(284532 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Nautica Apparel, Inc.,

Cancellation No.: 92052625

Petitioner,

Mark: AIRNAUTIC

v.

Reg. No. 3640791

AirNautic Watch Company,

Reg. Date: June 16, 2009

Registrant.

**PETITIONER'S RESPONSE TO REGISTRANT'S MOTION TO COMPEL
RESPONSES TO REGISTRANT'S FIRST REQUEST
FOR PRODUCTION OF DOCUMENTS**

Petitioner, Nautica Apparel, Inc. ("Petitioner" or "Nautica"), hereby objects to the Registrant's Motion to Compel dated April 29, 2011. Registrant's motion is without basis and fails to meet the requirements of 37 CFR § 2.120(e).

Background

On September 22, 2010, Registrant served upon Nautica its First Request for Production of Documents and Things (the "Requests"), which consisted of sixty-seven (67) separate Requests and its First Set of Interrogatories (the "Interrogatories"), which consisted of just fewer than seventy-five (75) delineated Interrogatories and well over seventy-five (75) Interrogatories including non-delineated compound questions or conjunctive questions.¹

¹ On March 4, 2011, Petitioner objected to the Interrogatories on the basis that the same violated 37 CFR § 2.120(d) as excessive. Registrant conceded this point on April 28, 2011 when it served upon Petitioner revised Interrogatories.

On March 4, 2011, pursuant to FRCP § 34, Nautica timely served its objections, written responses and produced 13,439 documents as they are kept by Nautica in the usual course of business, via a portable flash drive. Electronic service of documents was previously agreed to by counsel during the Initial Conference in this matter.

By letter dated April 11, 2011, counsel for Registrant contacted counsel for Nautica alleging discovery response deficiencies. A copy of said letter is attached hereto as Exhibit A. Interestingly enough, counsel's letter was not presented to the Board with Registrant's Motion to Compel.

The April 11 letter set forth four (4) issues: (1) That Nautica improperly objected to the Interrogatories on the basis that the same violated 37 CFR § 2.120(d) as excessive²; (2) That Nautica was required to produce documents pursuant to FRCP § 34; (3) That Nautica failed to provide a privilege log; and (4) That Nautica improperly objected to certain Requests on the basis that the documents sought are equally accessible to Registrant from public sources. Specifically, Registrant asserted that in connection with Request No. 29, "which seeks litigation documents related to enforcement efforts for its NAUTICA mark"... "Petitioner refer[red] Registrant to the TTAB and Pacer Websites."

By letter dated April 13, 2011, a copy of which is attached as Exhibit B, Nautica responded to the four (4) issues presented in the April 11 letter as follows: (1) Nautica properly objected to the Interrogatories pursuant to 37 CFR § 2.120(d); (2) Nautica produced responsive documents pursuant to FRCP § 34 as they are kept in the usual course of its business and Nautica offered Registrant the opportunity to review its files; (3) Nautica presented a privilege log; and (4) In response to Request No. 29, Nautica

² As indicated above, Registrant conceded this point on April 28, 2011 when it served upon Petitioner revised Interrogatories.

believed that its objections and response was proper. Nautica had already provided Registrant with unreported decisions it obtained from the TTAB. Nevertheless, Nautica supplemented its production with over one hundred additional representative documents (Bates Nos. 13440 through 13554).

Without any further response, on April 29, 2011, Registrant filed the instant motion to compel in which it alleges in pertinent part the following:

- 1) That Nautica's production was produced without organization or categorization;
- 2) That Nautica must fully respond to Request Nos. 12-14, 17-21, 23, 24, 26, 27, 33, 34, 36-41, 44, 47-49, 51, 52, 56, 59-65 and 67; and
- 3) That Registrant made a good faith effort to resolve the issues in the motion prior to making same.

Argument

Registrant's motion to compel is, at best, premature. 37 CFR §2.120(e) provides that, with regard to a motion to compel discovery,

A motion to compel initial disclosures, expert testimony disclosure, or discovery must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences.

Registrant should not use the deliberate omission of material facts in order to support a motion to compel and to support its declaration of good faith effort.

As discussed herein, Registrant's April 11th letter (i.e. its alleged "good faith effort"), contained only four (4) allegations. Of the four (4) allegations, three (3) were apparently resolved. The remaining issue presented by Registrant is that Nautica's production was produced without organization or categorization. Nautica strenuously objects to this mischaracterization to the Board. Registrant served at least sixty-seven (67) Requests calling for production of numerous documents from and throughout Nautica's near thirty (30) years of existence. Representative documents Bates stamped 1-13,554 were produced by category or topic as they are kept in the usual course of Nautica's business. Registrant's motion now alleges that the production was insufficient and that additional documents should be produced. Nautica went to great expense to electronically scan representative documents responsive to Registrant's numerous Requests. Nautica's production was in no way the paper "dump" being alleged by Registrant. There was no intent to bury any documents in this production and Nautica intends to use the produced documents at trial. Nautica is under no obligation to create an index for its production or to label its production since they were produced as they are kept in the usual course of business. Nevertheless, in an effort to resolve the matter Nautica offered Registrant the opportunity to review the same documents where they are kept in New York or New Jersey. Registrant never responded to this offer. Although not required, Nautica also offers the following broad categorization of the documents produced.

1. Corporate and Financial Reports (Bates Nos. 0000001- 0001058)
2. Product Documentation (Bates Nos. 0001059 – 0002819)
3. Marketing and Sales Data (Bates Nos. 0002820- 0002834)

4. Product Documentation Bates Nos. (0002835 – 0003599)
5. Product Documentation and Advertising (Bates Nos. 0003600 – 0004146)
6. Product Documentation (Bates Nos. 0004147 – 0004163)
7. Articles Referring to Nautica (Bates Nos. 0004164- 0009959)
8. Product Documentation (Bates Nos. 0009960- 0011748)
9. Sponsorships (Bates Nos. 0011749- 0012161)
10. Store Imagery (Bates Nos. 0012162- 0012185)
11. Product Documentation (Bates Nos. 0012186- 0012284)
12. Internet Materials (Bates Nos. 0012285-0012333)
13. Product Documentation and Promotion (Bates Nos. 0012334- 0012686)
14. Advertising, marketing, promotion, presence and sales information (Bates Nos. 0012687- 0013267)
15. Trademark Certificates (Bates Nos. 0013268- 0013353)
16. Enforcement Matters (Bates Nos. 0013354-0013554)

The April 11th letter from Registrant alone simply does not constitute sufficient “good faith effort” to resolve matters. As discussed above, the April 11 letter contained four allegations. Three have been resolved. The last concerning Nautica’s organization or categorization of its production has been thoroughly responded to despite the fact that there was only one letter issued by Registrant to resolve the issue. Now however, Registrant’s motion raises new allegations concerning Request Nos. 12-14, 17-21, 23, 24, 26, 27, 33, 34, 36-41, 44, 47-49, 51, 52, 56, 59-65 and 67 which were never the subject of any prior communication or Registrant’s April 11th letter. *See, Giant Food, Inc. v. Standard Terry Mills, Inc., 231 USPQ 626, 632 (TTAB 1986)* (Absent additional

documentation or other information indicating that a good faith effort was in fact made, one letter is not sufficient). *See also*, Envirotech Corporation v. Compagnie Des Lampes, 219 USPQ 448, 450 (TTAB 1979) (Where there has been a response to discovery which is unsatisfactory to the party seeking discovery, the moving party has a duty to confer with the opposing party to try to settle their disputes as to the propriety of the discovery requests and/or responses thereto). *See also* MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979); Ford Motor Co. v. Shelby International, Inc., 193 USPQ 236 (TTAB 1976); Daimler-Benz Aktiengesellschaft v. Hibner Products Mfg., Inc., 189 USPQ 479 (TTAB 1976); Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975); J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); Penthouse International Ltd. v. Dyn Electronics, Inc., 184 USPQ 117 (TTAB 1974); and Angelica Corp. v. Collins & Aikman Corp., 183 USPQ 378 (TTAB 1974).

Nautica is fully prepared to discuss and attempt to resolve all discovery disputes. As stated above, Registrant never communicated any objection to Nautica's response to Request Nos. 12-14, 17-21, 23, 24, 26, 27, 33, 34, 36-41, 44, 47-49, 51, 52, 56, 59-65 and 67. Any motion to compel concerning Request Nos. 12-14, 17-21, 23, 24, 26, 27, 33, 34, 36-41, 44, 47-49, 51, 52, 56, 59-65 and 67 is at best premature and simply cannot form the basis of a motion to compel. In the event that the Board determines that Registrant's Motion to Compel complies with 37 CFR § 2.120(e), Nautica respectfully reserves its right to substantively respond to these new allegations until such time that the Board rules on Registrant's perceived "good faith efforts."

For the foregoing reasons, Registrant's motion to compel should be denied as being improper.

BAKER & RANNELLS PA

Dated: May 20, 2011

By: /Neil B. Friedman/
Stephen L. Baker
Neil B. Friedman
575 Route 28, Suite 102
Raritan, NJ 08869
(908) 722-5640
Attorneys for Petitioner,
Nautica Apparel, Inc.

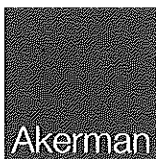
CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing was forwarded by First Class Mail on this 20th day of May, 2011 to the attorneys for the Registrant at the following address:

Jennifer Parkins Rabin, Esq.
Akerman Senterfitt
222 Lakeview Avenue, Suite 400
West Palm Beach, FL 33401-6183

/Neil B. Friedman/
Neil B. Friedman

EXHIBIT A



Jennifer P. Rabin

Akerman Senterfitt
222 Lakeview Avenue
Suite 400
West Palm Beach, FL 33401
Tel: 561.653.5000
Fax: 561.659.6313

April 11, 2011

Dir: 561.671.3671
jennifer.rabin@akerman.com

Via Email: n.friedman@br-tmlaw.com

Neil B. Friedman
BAKER AND RANNELLS, PA
575 Route 28, Suite 102
Raritan, NJ 08869

Re: Nautica Apparel, Inc. v. AirNautic Watch Company
Trademark Trial and Appeal Board Cancellation No. 92052625
Our Reference No. 10337-1 (58139/240364)

Dear Neil:

We are in receipt of your recent correspondence and discovery responses. We have reviewed the same and find them to be deficient in several respects.

First, we note your objection pursuant to 37 CFR 2.120(d) to the number of interrogatories served. We are well aware of the limitation on interrogatories in matters before the Trademark Trial and Appeal Board, and, therefore, carefully drafted Registrant's interrogatories so as to fall within the seventy-five interrogatory limit. Our further review of Registrant's First Set of Interrogatories confirms that the interrogatories served (including relevant subparts) do not exceed seventy-five. Accordingly, it is our belief that Nautica is obligated to respond to the interrogatories as served. Unless we hear from you with a further detailed explanation as to why you believe that the interrogatories are excessive, we will have no choice but to file a Motion to Compel your client to respond to the same.

Second, we have reviewed Petitioner's objections to the Requests for Production and the documents produced and note the following. Pursuant to FRCP 34, Nautica is required to produce documents as they are kept in the normal course of business (e.g., at a regular place of business, with file folders or other indications of document origination) or to identify by number/category the production request to which the documents are responsive. Nautica has done neither. Given the voluminous nature of the production (13,439 documents), the failure to observe the foregoing discovery rule has the effect of burying relevant documents like needles in a haystack.

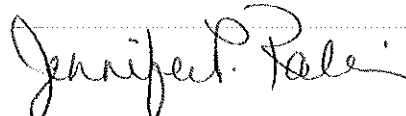
The foregoing deficiencies are particularly egregious where the Registrant repeatedly granted Nautica extensions of time to respond in connection with the continued exchange of settlement proposals between the parties. Responses to the original discovery requests were due in October 2010. Accordingly, your client has had ample time to retrieve and organize responsive documents in a manner consistent with the Federal Rules. Furthermore, we note your production did not include a privilege log, suggesting that no privileged documents were reviewed. We find this surprising in view of the number of discovery requests to which Petitioner objected on grounds that the request encompassed documents that are protected by the attorney-client privilege and/or the attorney work product privilege. Please confirm that no privileged documents were reviewed in connection with the production efforts and withheld.

Finally, we note that there appear to be document production requests to which Petitioner is refusing to respond or has mistakenly asserted that it is under no duty to respond where documents may be accessible to the Registrant. We disagree with your assertions. Specifically, in response to Document Request No. 29, which seeks litigation documents related to Petitioner's enforcement efforts for its NAUTICA mark, Petitioner responded as follows, "Petitioner refers Registrant to the TTAB and PACER websites." Such a response fails to meet the requirements of the rules of practice before the TTAB. We refer you to TBMP §414(10) which requires with respect to litigation matters that your client provide the "names of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding and the citation of the decision (if published)."

We write to you in the spirit of cooperation and look forward to hearing from you with respect to these matters.

Very truly yours,

AKERMAN SENTERFITT

A handwritten signature in black ink, appearing to read "Jennifer P. Rabin", is written over a horizontal dotted line.

Jennifer P. Rabin

JPR/erm

cc: AirNautic Watch Company

EXHIBIT B

BAKER AND RANNELLS, P.A.

INTELLECTUAL PROPERTY ATTORNEYS

STEPHEN L. BAKER ♦
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ADMITTED TO PRACTICE IN
♦ NEW YORK & NEW JERSEY
* NEW JERSEY & REG. PATENT
ATTORNEY

PLEASE RESPOND TO THE NEW JERSEY ADDRESS
EMAIL: N.FRIEDMAN@BR-TMLAW.COM

April 13, 2011

VIA FIRST CLASS MAIL

Jennifer Parkins Rabin, Esq.
Akerman Senterfitt
222 Lakeview Avenue, Suite 400
West Palm Beach, FL 33401-6183

RECEIVED
DOCUMENTS
APR 13 2011

AKERMAN SENTERFITT, P.A.

Re: Nautica Apparel, Inc. v. AirNautic Watch Company
Cancellation No. 92052625

Dear Ms. Rabin:

I am in receipt of your letter dated April 11, 2011.

My objection to the number of interrogatories served under 37 CFR §2.120(d) stands. We reviewed the interrogatories served several times and by my count you have just fewer than seventy-five (75) interrogatories with delineated subparts. That number grows well beyond the seventy-five (75) interrogatory limit when you include the numerous non-delineated compound questions or conjunctive questions. In order to resolve this dispute, I suggest that you serve revised interrogatories. Alternatively, we would be prepared to respond to the first seventy-five (75) interrogatories served by our count. If this is not acceptable, please make your motion.

With respect to Nautica's production, during our emails exchanged between August 18, 2010 and August 26, 2010, you agreed that "[I]n connection with document production, responsive documents shall be served upon counsel for the requesting party." On March 4, 2011, pursuant to FRCP 34, we produced 13,439 documents to Registrant's sixty-seven (67) Document Requests as they are kept in the usual course of business, via a portable flash drive. Nautica went to great expense to electronically scan representative documents responsive to Registrant's numerous Requests. I hasten to remind you that the Requests called for the production of numerous items from and throughout Nautica's near thirty (30) years of existence. The same were produced. There was no intent to bury any documents in this production and we intend to use the produced documents at trial in this

matter. Nautica is under no obligation to create an index for its production. Surely, our agreement to deliver the documents to your office was more economical and efficient for your client than your letter's suggestion that they be made available "at a regular place of business." We trust the Board would see it that way, too. Notwithstanding our prior agreement however, we would be amenable to discussing arrangements for you to come to New York or New Jersey to review the produced documents as they are kept. Any documents that you identify during that review can be flagged for printing at your client's expense.

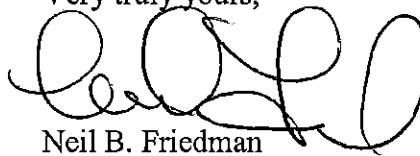
Your letter also mischaracterizes the various extensions of time that were previously agreed to while both sides labored over proposed settlement terms. It now appears to me that you insisted that I file for the agreed upon extensions simply for purposes of gamesmanship if settlement could not be reached. There has been no delay by Nautica in responding to Registrant's Requests.

As for a privilege log, we enclose one with this letter which is specifically relevant to your client and its registration. Nautica will not produce a privilege log concerning the numerous Requests made by Registrant that cover its legal communications with counsel and privileged documents that spans close to thirty (30) years.

Lastly, Nautica believes that it properly objected and responded to Request No. 29 since the documents and information responsive to the request are available through public sources and is equally available to Registrant as it is to Nautica. Indeed, Nautica already provided unreported decisions it obtained from the TTAB in its production to you. In order to avoid a dispute regarding this Request however, Nautica supplements its production with the enclosed representative documents and information gleaned from the TTAB and PACER websites already identified (See Bates Nos. 13440 through 13554). Any additional information is publicly available and can be obtained by Registrant independently.

We trust that the concerns raised in your letter have been fully addressed. Feel free to contact me if you wish to discuss these matters further.

Very truly yours,

A handwritten signature in black ink, appearing to read "Neil B. Friedman", written over a horizontal line.

Neil B. Friedman

NBF:aa
Enclosures